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Paper No. 7

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OCT 23 2002

OFFICE OF PETITIONS

In re Application of	:	
Walter Conard, Patrick Casher, John O'Callaghan,	:	
Daniel Gibbons, Frederick Hegland, Roy Schoon, and	:	
George Rabindran	:	
Application No. 10/087,446	:	DECISION REFUSING STATUS
Filed: March 1, 2002	:	UNDER 37 C.F.R. §1.47(a)
Attorney Docket No. 5384/55090	:	
Title: MAIL WEIGHING SYSTEM AND SCALE	:	
APPARATUS	:	

This is in response to the petition under 37 C.F.R. §1.47(a)<sup>1</sup>, filed August 22, 2002.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.47(a)."

On March 1, 2002, the application was deposited, identifying Walter Conard, Patrick Casher, John O'Callaghan, Daniel Gibbons, Frederick Hegland, Roy Schoon, and George Rabindran as joint inventors. The application was deposited without an executed oath or declaration. On March 22, 2002, a "Notice to File Missing Parts of Nonprovisional Application – Filing Date Granted" (Notice) was mailed, indicating that an executed oath or declaration, a surcharge of \$130.00, and the basic filing fee were required. This Notice set a two-month period for reply.

<sup>1</sup>A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application;
- (3) a statement of the last known address of the non-signing inventors;
- (4) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review;
- (5) proof that the non-signing inventor refuses to sign the oath or declaration after having been presented with the application papers if the inventor refuses to sign, or proof that diligent efforts have been made to locate the non-signing inventor if he or she cannot be found, and;
- (6) a declaration which complies with 37 CFR §1.63.

With the instant petition, the petitioner has included the filing fee for the petition, the \$130.00 surcharge, a three (3) month extension of time to make timely this reply, a declaration executed by each inventor save inventor Gibbons, statements of facts from both the petitioner<sup>2</sup> and Maribel Barron, an employee of the assignee, and copies of a letter sent to the non-signing inventor.

Petitioner has met requirements (1)-(2) of 37 C.F.R. §1.47(a) above.

Regarding the third requirement, petitioner has failed to include a statement of the last known address of the non-signing inventor<sup>3</sup>.

Regarding the fourth requirement above, the statement of Ms. Barron "I sent a package...to Daniel Gibbons...the package was sent next day air via Airborne Express with a tracking number of 15524280951" is insufficient, for the following two reasons. First, the statement does not reveal where the package was sent. Secondly, a tracking search on the Airborne Express for this number suggests that this tracking number does not exist<sup>4</sup>. Where a refusal of the inventor to sign the application papers is alleged, the Office requires the petitioner to establish that a bona fide attempt was made to mail a complete copy of the application, which entails the specification, claims, drawings, and oath or declaration.<sup>5</sup> On renewed petition, it should be established that a complete copy of the application was sent to the non-signing inventor.

Regarding the fifth requirement above, it follows that since it has not been shown that a complete copy of the application was sent to the inventor, one cannot refuse to sign something which one has not seen. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed<sup>6</sup>.

Regarding the sixth requirement, petitioner has not submitted a declaration which complies with 37 CFR §1.63. The declaration submitted with the instant petition contains non-initialed and non-dated changes by inventor Hegland<sup>7</sup>. Furthermore, the declaration fails to contain the residential address, mailing address, and citizenship information for non-signing inventor Gibbons<sup>8</sup>.

On renewed petition, the petitioner must submit a new declaration executed by each of the non-signing inventors, or he may submit a fully executed declaration if available.

There is no indication that the person signing the present petition was ever given a power of attorney or authorization of agent to prosecute the instant application. Moreover, the application does not indicate a change of address has been filed in the case, although the address given on the petition differs from the address of record. If petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent documentation and change of correspondence address must be submitted. While a courtesy copy of this decision is being mailed to the person signing the present petition, all future correspondence will be directed to the address currently of record until such time as appropriate instructions are received to the contrary.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being

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<sup>2</sup> It is noted that this attorney is not listed as an attorney of record.

<sup>3</sup> See MPEP 409.03(e).

<sup>4</sup> See enclosure.

<sup>5</sup> See MPEP 409.03(d).

<sup>6</sup> *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

<sup>7</sup> See 37 C.F.R. §1.52(c)(1).

<sup>8</sup> See 37 C.F.R. §§1.63(c)(1), 1.63(a)(3).

treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay<sup>9</sup>. In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

In light of the recent events, the USPTO **strongly** prefers that the reply to this letter be submitted by facsimile<sup>10</sup>. However, if applicant cannot submit the reply to this letter by facsimile (or hand-delivery<sup>11</sup>), the reply may be mailed<sup>12</sup>.

**The application file will be retained in the Office of Petitions for two (2) months.**

The request for a corrected filing receipt has been noted, however one cannot be issued at this time due to problems with the software utilized by the Office. Petitioner is advised to make a second request for a corrected filing receipt upon renewed petition.

Telephone inquiries should be directed to Petitions Attorney Paul Shanoski at (703) 305-0011.



Beverly M. Flanagan  
Supervisory Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

encl. Power of Attorney Form (PTO/SB/81)  
Airborne Express Tracking Report  
Summary of the Privacy Act of 1974

cc: David M. Tennant  
600 13<sup>th</sup> Street, NW  
Washington, DC 20005-3096

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<sup>9</sup> See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997).

<sup>10</sup> (703) 308-6916, Attn: Office of Petitions.

<sup>11</sup> Office of Petitions, 2201 South Clark Place, Crystal Plaza 4, Suite 3C23, Arlington, VA 22202.

<sup>12</sup> Commissioner for Patents, Box DAC, Washington, DC 20231.